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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/806,311

03/22/2004

Matthew F. Ogle

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EXAMINER

NGUYEN, VI X

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

12/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/806,311

**Applicant(s)**

OGLE, MATTHEW F.

**Examiner**

Victor X. Nguyen

**Art Unit**

3734

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2008 and 03 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statements(s) (PTO/SB08)
- Paper No(s)/Mail Date 9/2/2008.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The request filed on 6/16/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/806,311 is acceptable and a RCE has been established. An action on the RCE follows.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 and 21-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is unclear how one or more grooves occur along the length of the surface capillary fibers.

#### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. None of the drawings of Applicant illustrates a reference number *one or more grooves* along the length of the fiber as recited in claim 1. Corrected drawing sheets in compliance with 37 CFR 1.121 (d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be

renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,5,9-10,13-14, 21,23-26 and 28-29 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Macoviak et al. (U. S. 6,395,014).

Macoviak discloses in figure 1, an embolism protection device having the limitations of the above listed claims, including: a plurality of fibers 112 which has surface capillaries with grooves extending along the length of the fiber (fibers 112 have multiple of open space thus these open space are equivalent with groove which occurs along the length of fibers 112) and are bound to the device which has a deployed configuration that fills the lumen of a vessel having a diameter corresponding to the human vessel in the form of a porous structure (see fig. 1). Macoviak is silent regarding the porous structure that blocks a substantial majority of

particulates with a diameter greater than 0.2 mm. Nevertheless, Macoviak does disclose an embolism device that has a porous structure, where changes in diameter or the size of a component involve merely routine skill in the art. Applicant has not disclosed that such an expansion diameter greater than 0.2 mm of the device is to solve a particular problem or is for any stated purpose and it appears that other expansion diameter of the device would work equally well in embolism protection device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make Macoviak's device with a structure that has a diameter of greater than 0.2 millimeters, which allows the particulates to filter flow, where the fibers are within a fabric (see col. 5, lines 28-38), where the device further comprises a tether which is a guidewire 104, and where the device is capable to attach to the tether with an adhesive at best seen in fig. 1.

Claims 2-4 and 12 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Macoviak. Macoviak discloses the invention substantially as claimed. However, Macoviak is silent regarding the fibers comprises a hydrophilic polymer, polyester, or a bioresorbable polymer or a biocompatible adhesive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the fibers comprises a hydrophilic polymer, polyester, or a bioresorbable polymer or a biocompatible adhesive, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use or as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 6-8, 22 and 27 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Macoviak et al. in view of Thompson et al (5,200,248).

Macoviak et al disclose the invention substantially as claimed. However, Macoviak is silent regarding the fibers are curled or are in a bundle. Thompson et al teach the fibers are curled or are in a bundle (figures 24-26). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Macoviak by making the fibers are curled or are in a bundle as taught by Thompson in order to have a better entrapping emboli when these fibers are in a bundle or curled configuration, because one of ordinary skill in the art would have been able to carry out such a substitution, and the results were reasonably predictable.

***Response to Amendment***

5. Applicant's arguments filed 9/3/2008 have been fully considered but they are not persuasive. Applicant is asked to please refer to the modified prior art rejections above where examiner address applicant's concerns regarding prior art rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

/Victor X Nguyen/  
Examiner  
Art Unit 3734

VN